

## REMARKS

Claims 1-36 are pending in the instant application. Claims 1-36 are rejected. Claims 1, 10, 19 and 28 are amended herein. Reconsideration of the Application and Claims is respectfully requested.

### 101 Rejections

Claims 1-9 and 28-36 is rejected under 35 USC 101 because the claimed invention is contended to be directed to non-statutory subject matter. The Examiner contends that the embodiments of Applicants' invention that are set forth in Claims 1-9 are "so abstract as to cover the method if practiced by a human operator assisted only by pencil and paper" and further that a "method of this sort, traditionally called a 'mental process', is not patentable subject matter." The Applicants respectfully disagree with these contentions. Moreover, Applicants respectfully submit that the embodiments of the invention that are set forth in Claims 1-9 cannot properly be characterized as being directed to a mere abstract "mental process". In contrast, Claims 1-9 expressly recite material operations (e.g., automatically including a selected sequence of sections, subsections, fields etc. in a document) that are performed with respect to material structures (e.g., sections, sub-sections and fields of a document). Accordingly, these Claims recite concrete and material operations that are a part of a clearly statutory category of invention (e.g., a process).

With regard to Claims 28-36, the Examiner contends in essence that the embodiments of the invention that are set forth in these Claims are directed to non-statutory subject matter because they are not embodied in a computer readable medium and that they encompass non-descriptive data structures. Applicants respectfully disagree as Claims 28-36 are presented in

the well known means plus function format. These types of Claims are generally accepted as constituting a statutorily acceptable form. Moreover, this claim form on its face is not related per se to “data structures” (e.g., packets, frames, bits, bytes etc.). Consequently, as the Claims are in fact directed to statutory subject matter as is indicated by the above discussion, Applicants respectfully request a withdrawal of the 35 USC 101 rejection of Claims 1-9 and 28-36.

### 103 Rejection

Claims 1-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spencer (U.S. Patent No. 6,356,909) in view of Gurne et al. (U.S. Patent No. 5,541,840). The Applicants have reviewed the cited references and respectfully submit that the embodiments of the present invention as are recited in Claims 1-36 are neither anticipated nor rendered obvious by Spencer.

The Examiner is respectfully directed to independent Claim 1, which recites that embodiments of the present invention are directed to a method for generating a plurality of templates, and comprises:

...displaying to the user said selected template, wherein said selected template enables a user to select said sections, sub-sections and fields for inclusion in a particular document to be built, and said selected template enables a user to select the sequence of said sections, sub-sections, and fields in said particular document to be built, and in response to a selection of the sequence, the sequence of sections, sub-sections, and fields that is selected is automatically provided in a completed document. (emphasis added)

Claims 10, 19 and 28 contain limitations similar to those of Claim 1. Claims 2-9, 11-18, 20-27 and 29-36 depend from Claims 1, 10, 19 and 28 respectively and recite further limitations of embodiments of the present invention.

Spencer does not anticipate or render obvious a method for generating a plurality of templates wherein selected templates to be included in the document enable the selection of sections, sub-sections and fields for inclusion in the document to be built, and a selected template “enables a user to select the sequence of the sections, sub-sections, and fields in the particular document to be built, and in response to a selection of the sequence, the sequence of sections, sub-sections, and fields that is selected is automatically provided in a completed document” as is recited in Claim 1 (Claims 10, 19 and 28 recite similar limitations). Spencer only shows a web-based system for managing a request for proposal and responses. It should be noted that Spencer is concerned with content but is not concerned with the automatic ordering of a selected sequence of sections, sub-sections and fields.

In fact, nowhere in the Spencer reference is it taught or suggested that a selected template enables a user to select sections, sub-sections and fields for inclusion in a document that is under construction wherein in response to a selection of a sequence of the sections, sub-sections, and fields the sequence for these components is automatically provided in a completed document.

Gurne et al. does not teach or suggest a modification of Spencer that would remedy the deficiencies of Spencer noted above. More specifically, Gurne et al. does not teach or

suggest a method for generating a plurality of templates wherein selected templates to be included in the document enable a selection of sections, sub-sections and fields for inclusion in the document to be built, and a selected template “enables a user to select the sequence of the sections, sub-sections, and fields in the particular document to be built, and in response to a selection of the sequence, the sequence of sections, sub-sections, and fields that is selected is automatically provided in a completed document” as is recited in Claim 1 (Claims 10, 19 and 28 recite similar limitations). Gurne et al. only shows a hand-held automotive diagnostic tool. It should be noted that Gurne et al. was not employed to, and does not address the deficiencies of Spencer outlined above. In fact, nowhere in the Spencer reference is it taught or suggested that a selected template enables a user to select sections, sub-sections and fields for inclusion in a document that is under construction wherein in response to a selection of a sequence of the sections, sub-sections, and fields the sequence of sections, sub-sections, and fields that is selected is automatically provided in a completed document. Consequently, the embodiments of the Applicants’ invention as are set forth in Claims 1, 10, 19 and 28 are neither anticipated nor rendered obvious by Spencer in view of Gurne et al.

Accordingly, Applicants also respectfully submit that Spencer in view of Gurne et al. does not anticipate or render obvious the present claimed invention as is recited in Claims 2-9 dependent on Claim 1, Claims 11-18 dependent on Claim 10, Claims 20-27 dependent on Claim 19 and Claims 29-36 dependent on Claim 28 and that these Claims overcome the rejection under 35 U.S.C. 103(a) as being dependent on an allowable base claim.

### Conclusion

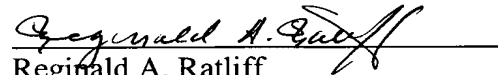
In light of the above-listed remarks, Applicants respectfully request allowance of the remaining Claims.

The Examiner is urged to contact the Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

WAGNER, MURABITO & HAO LLP

Dated: 2/23, 2006

  
Reginald A. Ratliff  
Registration No. 48,098  
Two North Market Street  
Third Floor  
San Jose, CA 95113  
(408) 938-9060